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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,533	08/26/2003	Yuzo Fukunaga	116919	2272
25944	7590	09/20/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/647,533	Applicant(s) FUKUNAGA ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/04/04 & 08/26/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/24/2003</u> . | 6) <input checked="" type="checkbox"/> Other: <u>partial translation of JP 08-324575</u> |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 16-19 in the reply filed on August 4, 2004 is acknowledged. The traversal is on the ground(s) that all of the claims in the application are sufficiently related that the search and examination of all of the claims could be made without serious burden.

This is not found persuasive because it is the Examiner's position that the inventions are distinct and there is a serious burden on the Examiner to examine both inventions. In particular, it is noted that the two inventions have separate classifications as set forth in the restriction requirement dated July 6, 2004. The product with the protrusions is classified in a general printer housing area (400/693), while the printing process is classified in a screen printing area (101/129). Furthermore, the Examiner points out that the two groups also require different fields of search. For example, in the first invention drawn to the printed product (i.e., the molded component per se or the operation panel or electronic device having the molded component), how the print is applied to the product is of no patentable significance to the claims. Note that claims 6 and 8 are improper since they are reciting a functional mode of manufacture in claims drawn to a product per se. Again, since the claims are drawn to a printed product per se, the print could have been applied in a variety of different ways (i.e., inkjet, gravure, etc.) to result in the product as

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recited. On the other hand, group II specifically recited a method of making a molded component including screen printing the indicia on the component. Therefore, group I (the printed product claims) would require searching of many different types of printing applications to print a protrusion on a product (such as inkjet, gravure, etc.) while group II specifically requires searching of screen printing areas. Furthermore, at least some of the product claims specifically require the molded device to be part of an operation panel and/or electronic device. Therefore, group I would also require additional searching of operation panels and electronic devices.

In view of the above reasoning, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-15 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 4, 2004.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanao (JP 08-324575) in view of Schneider et al. (US 4,063,665). Kanao teaches a method as recited comprising printing a character of the surface of a member and printing a protrusion on the surface of the member on which the character has already been printed. See, in

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particular, the partial English language translation of JP '575 attached to this Office Action. Note the object being printed in Kanao is a container, which Kanao teaches may be made of synthetic resin (see paragraph 0010 of the partial translation). Although Kanao is silent with respect to whether the resin container is a molded member, Schneider et al. teach that a molded synthetic plastic container is well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a molded member as taught by Schneider et al. in the method of Kanao as it would simply require the obvious substitution of one known container member for another to allow for easier manufacture of the container product and to allow for printing information for both sighted and sightless persons on a molded container.

With respect to claim 18, note the container surface of Kanao (as modified by Schneider et al.) will inherently have a grain surface (i.e., minor variations in height) with upper-leveled and lower leveled portions and the protrusion printing step uses a plate film (see paragraph 0009 of Kanao translation) that would clearly have a thickness greater than a distance between the upper leveled and lower leveled portions of the surface in order to produce protrusions that are distinguishable from the container surface by touch.

With respect to claim 19, note the container of Kanao (as modified by Schneider et al.) has a curved surface and includes the first and second print regions as shown in Figure 2 of Kanao in particular.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanao in view of Schneider et al. as applied to claims 16, 18 and 19 above, and further in view of Thompson, Sr. (US 5,740,730). Kanao in view of Schneider et al. teach a method as recited with the possible exception of the through holes of the second screen having a size greater than the size of the through holes of the first screen. Note Kanao teaches screen printing the characters on the surface in paragraph 0006 and also screen printing the protrusion on the surface in paragraph 0007, but is silent with respect to the particular sizes of the through holes. However, the use of two printing screens with through holes of different sizes to produce different size/thickness indicia is well known in the art, as exemplified by Thompson, Sr., for example in Figures 1 and 5. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the through holes of the second screen printing the protrusions in Kanao to be greater than the size of the through holes of the first screen which printed the characters on the component surface to allow for a thicker, raised indicia or protrusion to be easily printed upon the component.


Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fukumoto (US 5,779,482), Yim (US 5,649,480), Maie (JP 2002-36713), Perez et al. (WO 94/00301), Onishi (JP 2001-209299), and JP 2001-318593 each teach a protrusion printing method having obvious similarities to the claimed subject matter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
September 16, 2004